

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Bottorff

Opposition No. 123,203

American Century Services
Corp.

v.

Vista Investment Advisors
LLC

Before Quinn, Bucher and Bottorff, Administrative Trademark
Judges.

Bottorff, Administrative Trademark Judge:

INTRODUCTION AND BACKGROUND

This case now comes up on opposer's February 28, 2002
contested motion for summary judgment on its pleaded Section
2(d) ground of opposition. The motion is fully briefed.
Because we find that no genuine issue of material fact
exists, and that opposer is entitled to judgment as a matter
of law, we grant opposer's summary judgment motion. See
Fed. R. Civ. P. 56(c).

In its intent-to-use application Serial No. 76/053,882,
filed on May 23, 2000, applicant seeks registration on the

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Principal Register of the mark VISTA FINANCIAL STRATEGIES (with a disclaimer of FINANCIAL STRATEGIES) for services which are recited in the application, as amended, as "providing financial services, namely estate planning, retirement planning, and general financial planning; financial investment in the field of securities; life and medical insurance underwriting."

Opposer filed a notice of opposition to registration of applicant's mark, alleging as grounds therefor that opposer has used the mark VISTA in connection with mutual fund brokerage, distribution and investment services continuously since at least as early as 1983; that applicant's mark, as applied to applicant's services, so resembles opposer's VISTA mark as to be likely to cause confusion, to cause mistake, or to deceive; and that registration of applicant's mark therefore is barred under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant filed an answer to the notice of opposition, by which it denied the allegations made therein which are essential to opposer's Section 2(d) claim. Applicant also alleged, affirmatively, that there are numerous third-party registrations in the financial services field of marks containing the word VISTA; that there also are numerous unregistered VISTA marks in use in connection with financial

services; and that "the ultimate channels of trade for its services are different from those of the Opposer's."

The record before us on summary judgment consists of the pleadings, the file of the opposed application, the affidavit (and attached exhibits) of Michael Barr, opposer's Senior Vice-President of Corporate Marketing, and the affidavit (and attached exhibits) of applicant's counsel of record in this case, Julianne B. Bochinski.¹ In reviewing the evidence of record and in making our findings with respect thereto, we are governed by the following legal principles.

SUMMARY JUDGMENT

The purpose of summary judgment is judicial economy, that is, to save the time and expense of a useless trial where no genuine issue of material fact remains and more

¹ We agree with opposer's contention in its reply brief that this affidavit is not in compliance with the requirements of Fed. R. Civ. P. 56(e), and that it is entitled to very little, if any, probative value or weight in our summary judgment analysis. The factual averments in the affidavit are not asserted to be made, nor do they appear to be made, on Ms. Bochinski's personal knowledge, nor is there any basis in the record for concluding that she is otherwise competent to testify to those factual matters. Moreover, and as noted more specifically *infra*, most of the factual averments made in the affidavit are legally irrelevant and are therefore immaterial to our analysis. Additionally, Ms. Bochinski's affidavit contains legal arguments and statements of opinion which are not evidence and which do not belong in a summary judgment affidavit; we have considered such arguments to be supplemental to applicant's one-page summary judgment opposition brief. In sum, while we have not disregarded the affidavit in its entirety as opposer has requested us to do, we are aware of the affidavit's deficiencies, and we have accorded it only as much probative value as it deserves.

evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result. See *Kellogg co. v. Pack-Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990, *aff'd* 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). An issue of fact is material when its resolution would affect the outcome of the proceeding under governing law. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A fact is genuinely in dispute if the evidence of record is such that a reasonable factfinder could return a verdict in favor of the nonmoving party. *Id.* The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Finally, when the moving party's summary judgment motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment as a matter of law, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. See Fed. R. Civ. P. 56(e); *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

OPPOSER'S STANDING

After careful review of the evidence of record in accordance with the foregoing legal principles, we find, first, that there is no genuine issue of material fact as to opposer's standing to bring this opposition proceeding. The undisputed evidence of record (Barr affidavit ¶3 and attached exhibits) establishes that opposer has continuously used the mark VISTA in interstate commerce in connection with its various mutual fund investment services since 1983, which (as discussed *infra*) is prior to any date upon which applicant can rely for Section 2(d) priority purposes. In view thereof, and because (as discussed *infra*) opposer's

likelihood of confusion claim is not without merit, we find that opposer has a real interest in the outcome of this proceeding and a reasonable basis for its belief that it would be damaged by registration of applicant's mark, and that opposer accordingly has standing. See Trademark Act Section 13, 15 U.S.C. §1063; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987).

OPPOSER'S PRIORITY

We also find that there is no genuine issue of material fact as to opposer's Section 2(d) priority. First, there is no genuine dispute that opposer's common law mark VISTA is distinctive as applied to opposer's investment services. Webster's Ninth New Collegiate Dictionary (1990), at 1318, defines "vista" as "a distant view through or along an avenue or opening" and as "an extensive mental view (as over a stretch of time or a series of events)." We take judicial notice of this dictionary definition. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). Moreover, at ¶12 of his affidavit, Mr. Barr states that "vista" is a term which "has no recognized meaning which in any way describes investment services." There is no evidence in the record which contradicts this

statement. We therefore find that opposer has trade identity rights in its unregistered VISTA mark which it is entitled to assert in support of its Section 2(d) claim. See *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039 (Fed. Cir. 1990); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). Applicant has not contended otherwise.²

Second, and as noted above, the undisputed evidence of record establishes that opposer has used its VISTA mark in connection with its mutual fund services continuously since 1983. The earliest date upon which applicant can rely for Section 2(d) priority purposes is its intent-to-use application filing date, May 23, 2000. In view thereof, we find that opposer's VISTA mark is a mark "previously used in the United States by another and not abandoned," and that opposer therefore has established its priority vis-à-vis applicant, under Trademark Act Section 2(d).

² We shall discuss *infra* applicant's contention (at Bochinski affidavit ¶5) that the alleged existence of numerous uses and registrations by third parties of marks containing the term VISTA renders that term "somewhat diluted" in the financial services industry. Applicant has not contended that VISTA is, per se, non-distinctive as applied to financial services such as opposer's.

LIKELIHOOD OF CONFUSION

We next determine whether any genuine issue of material fact exists with respect to the likelihood of confusion prong of opposer's Section 2(d) claim. Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); see also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and cases cited therein. The ultimate issue of whether a likelihood of confusion exists is a question of law, to be resolved by the Board on the basis of the factual evidence of record pertaining to the underlying *du Pont* evidentiary factors. *Sweats Fashions Inc. v. Pannill Knitting Co., Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

Similarity of Marks

First, we turn to a determination of whether applicant's mark VISTA FINANCIAL SERVICES and opposer's mark VISTA, when compared in their entirety in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

We find that VISTA is the dominant feature in the commercial impression created by applicant's mark. It is the first word in applicant's mark, and it therefore is more likely to be perceived and recalled by purchasers. Moreover, VISTA is distinctive as applied to applicant's

services; indeed, it is the only distinctive matter in applicant's mark. Although we do not disregard the descriptive and disclaimed wording FINANCIAL STRATEGIES in applicant's mark, we find that it has relatively little source-indicating significance and that it contributes relatively little to the mark's overall commercial impression.

VISTA, the dominant feature of applicant's mark, is identical to opposer's mark VISTA in terms of appearance, sound, and connotation. Applicant's mark consists essentially of opposer's mark in its entirety, VISTA, plus the descriptive and disclaimed wording FINANCIAL STRATEGIES. In comparing the marks' overall commercial impressions, we find that any dissimilarities which result from the presence in applicant's mark of the descriptive and disclaimed words FINANCIAL STRATEGIES are greatly outweighed by the basic similarity between the marks which results from the presence in both marks of the distinctive word VISTA.

For these reasons, we find that applicant's mark is sufficiently similar to opposer's mark that confusion is likely to result if the marks were to be used in connection with similar services. There is no genuine issue of material fact as to the first *du Pont* factor, and that factor weighs in opposer's favor in our likelihood of confusion analysis. Applicant has not contended otherwise.

Similarity of Services

We turn next to a consideration of the similarity or dissimilarity between the parties' respective services, under the second *du Pont* evidentiary factor. The undisputed evidence of record establishes that opposer uses its mark in connection with "mutual fund brokerage, distribution, and investment services," and that opposer's VISTA mutual fund "is a mutual fund that owns the securities of publicly traded corporations and other investments." (Barr affidavit at ¶3.) Nor is there any dispute that opposer

offers a number of investment services in connection with its VISTA mutual fund, including providing investors with information regarding the fund, selling mutual funds under the mark to investors, providing investors with performance information regarding the status of their investments, exchanging shares of other funds from and to its VISTA fund, and redeeming shares of the fund by providing investors with redemption checks.

(Barr affidavit at ¶4.)

Applicant's services, as recited in the application, are "providing financial services, namely estate planning, retirement planning, and general financial planning; financial investment in the field of securities; life and medical insurance underwriting." It is these services, as recited, that we must compare to opposer's services in

making our determination under the second *du Pont* factor, even if the actual services applicant renders or intends to render might be more limited in scope. See, e.g., *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); and *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001). Thus, applicant's effort (in its summary judgment papers) to more narrowly describe and define the scope and nature of its services is unavailing.³

Applicant's argument that its services "are different and can be distinguished from those of the Opposer" is not persuasive.⁴ It is not necessary that the parties' respective services be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the services are related in some manner, or that the circumstances surrounding their

³ Specifically, applicant contends that it "is a small Connecticut-based business that seeks to help individuals in New England directly, to assist [sic - help] them strategize and plan for their financial future by providing advice for their estate planning needs, long term investments as well as assisting them in obtaining life and medical insurance" (Bochinski affidavit at ¶4), and that it is "a small business aimed at working directly with advising individuals on their estate planning, long-term investment and insurance needs" (*id.* at ¶8). Even if we were to accept these statements by Ms. Bochinski as evidence (see *supra* at footnote 1), they are immaterial to our likelihood of confusion analysis and they therefore fail to create a genuine issue of material fact.

⁴ Applicant's summary judgment brief at 1.

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marketing are such, that they would be likely to be
encountered by the same persons in situations that would

give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods or services. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978).

We find that opposer's services and applicant's services are sufficiently similar that confusion is likely to result from the parties' use of their respective, confusingly similar, marks. Indeed, applicant's services, insofar as they include "financial investment in the field of securities," encompass and therefore are legally identical to opposer's mutual fund investment services. We further find that there is no genuine issue of material fact as to the similarity of the parties' services under the second *du Pont* factor, and that this factor weighs in opposer's favor in our likelihood of confusion analysis.

Trade Channels

We likewise find that there is no genuine issue of material fact as to the similarity of the trade channels through which the parties' respective services are marketed, under the third *du Pont* factor. There is no dispute that

opposer offers its various investment services "directly to individual investors" via its own retail outlets, by phone, by mail, and over the Internet via opposer's website. (Barr affidavit, ¶6.) Nor is there any dispute that individual investors are able to purchase interests in opposer's mutual fund "from intermediaries such as mutual fund or securities brokers, banks, and insurance companies," or that opposer also markets the fund in non-retail fields including "institutional sales and [to] retirement planholders, such as 401(k) participants." (*Id.*)

There likewise is no dispute as to applicant's trade channels. Applicant's recitation of services contains no limitation or restriction as to the trade channels in which applicant markets, or intends to market, its services. Accordingly, we must presume that applicant's services will be offered in all normal trade channels for such services. See *Canadian Imperial Bank of Commerce, supra*.⁵ Those

⁵ At paragraph 4 of her affidavit, applicant's counsel asserts that applicant "is a small Connecticut-based business that seeks to help individuals in New England..." At paragraph 8 of her affidavit, applicant's counsel asserts that "Opposer's services appear to be directed at investors in Missouri, Kansas, California and Colorado according to the Opposer's Motion for Summary Judgment which is not a territory Applicant will enter into." (Here we assume, *arguendo*, that applicant's counsel's statements regarding the geographic scope of applicant's services are admissible evidence; see *supra* at footnote 1.) To the extent that applicant, by these statements, is contending that the parties operate in different geographic areas and therefore in different trade channels, applicant clearly is incorrect both on the facts and on the law. The undisputed evidence of record shows that opposer operates "retail outlets or investor centers" in Missouri, Kansas, California and Colorado, but also that it

normal trade channels would include the retail trade channels through which opposer markets its own services. This similarity and overlap in the parties' respective trade channels weighs in opposer's favor in our likelihood of confusion analysis, under the third *du Pont* evidentiary factor.

Sophistication of Purchasers

There is no evidence in the record relating specifically to the fourth *du Pont* evidentiary factor, i.e., "the conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing." Thus, there is no basis for concluding, in opposer's favor, that the parties' respective services would ever be purchased impulsively by unsophisticated purchasers.⁶ However, neither can we conclude in

markets and renders its services nationwide via phone, mail, the Internet, and third-party intermediaries. Applicant's contention that opposer "asserts a limited common law right to the mark VISTA in the areas of Missouri, Kansas, Colorado and California" is a patent misrepresentation of opposer's claim and of the evidence in the record. More fundamentally, because applicant seeks a registration which is nationwide in scope, it would be irrelevant under the third *du Pont* factor (even if true) that the parties operate in different geographic locations. Cf. Trademark Rule 2.133(c), 37 C.F.R. §2.133(c) ("Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use proceeding").

⁶ At unnumbered pages 12-13 of its brief, opposer contends that because its mutual fund is marketed to non-professional individual investors at the retail level, "it may be recognized that some of these consumers will likely rely on word-of-mouth and reputation as to past performance in addition to a prospectus with regard to their investment decisions." There is no evidence in the record which supports counsel's speculation.

applicant's favor (nor has applicant even argued) that such services necessarily are purchased with care by sophisticated purchasers. Therefore, we find that the fourth *du Pont* factor is essentially neutral in this case.

Fame of Opposer's Mark

Opposer argues that its mark is famous, under the fifth *du Pont* factor. There is no genuine dispute as to the facts upon which opposer bases its claim of fame, i.e., that there are 96,000 investment accounts in opposer's mutual fund, that there is over \$1 billion invested in opposer's fund, that opposer has spent over \$8 million in advertising and promoting its mark, and that members of the relevant purchasing public have made unsolicited postings at investor-related websites which demonstrate that they are familiar with opposer's fund. (Barr affidavit, ¶¶8-10 and 13.)

We find that this undisputed evidence is sufficient to establish that opposer's VISTA mark is a strong mark which has achieved a degree of recognition among the relevant purchasing public. However, we cannot conclude on this record that opposer's mark is necessarily a famous mark, such that the fifth *du Pont* factor should be deemed to be the dominant factor in our likelihood of confusion analysis. *Cf. Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63

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USPQ2d 1303 (Fed. Cir. 2002); *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). The raw numbers presented by opposer (i.e., 96,000 investment accounts in opposer's fund, over a billion dollars invested in the fund, and \$8 million spent advertising the mark) appear to be substantial, but there is no evidence from which we might determine the relative significance of these numbers in the context of opposer's industry.

Thus, we find that the fifth *du Pont* factor is essentially neutral in this case, or at most it weighs only slightly in opposer's favor. Nonetheless, even if opposer's mark is not famous mark under the fifth *du Pont* factor, the evidence establishes that it is a strong mark.

Third-party Uses

The sixth *du Pont* factor requires us to consider any evidence of record relating to "the number and nature of similar marks in use on similar goods [or services]." Applicant relies on the alleged existence of third-party registrations (in the financial services field) of marks containing VISTA or some variation thereof. Even if such third-party registrations exist, however, (and, as opposer correctly notes, applicant has not properly made any such registrations of record), they are not probative evidence of

third-party use under the sixth *du Pont* factor. See *Olde Tyme Foods Inc. V. Roundy's Inc.*, *supra*. They do not suffice to create a genuine issue of material fact under the sixth *du Pont* factor.

At paragraph 7 her affidavit, applicant's counsel asserts: "As stated in Applicant's Answer to Notice of Opposition in paragraph 1 [sic - 11],⁷ there are numerous common law uses of the term VISTA as used in connection with financial, investment and insurance services. Please see attached Schedule A." We find that this statement by applicant's counsel, and the documents submitted in support thereof (as Schedule A), fail to establish the existence of a genuine issue of material fact as to the sixth *du Pont* factor which would preclude entry of summary judgment for opposer.

First, as noted *supra* at footnote 1, Ms. Bochinski's affidavit is not asserted to be made on personal knowledge, nor does the affidavit affirmatively show that she is otherwise competent to testify to the factual matters asserted in the affidavit. See Fed. R. Civ. P. 56(e). Specifically, she offers no basis for her conclusory assertion that there are "numerous" common law third-party

⁷ Paragraph 11 of applicant's answer to the notice of opposition reads as follows: "Applicant further affirmatively alleges that there are numerous marks in existence that are not on the U.S. Federal Register that contain the word VISTA used in connection with financial services."

uses of VISTA marks in the financial services field. The affidavit contains no mention of any trademark or trade name search having been conducted or commissioned by Ms. Bochinski, nor does it contain any other affirmative showing as to how she knows or is able to aver that there are "numerous" third-party common law uses of VISTA marks in the financial services field. Her conclusory assertion is nothing but a reiteration of the mere allegation pleaded in paragraph 11 of applicant's answer to the notice of opposition; it is not evidence, and it does not create a genuine issue of material fact. See Fed. R. Civ. P. 56(e).

Second, we find that the three documents attached as Schedule A to Ms. Bochinski's affidavit fail to establish that there is a genuine issue of material fact as to the sixth *du Pont* evidentiary factor which would preclude entry of summary judgment for opposer.⁸ For purposes of deciding opposer's summary judgment motion, we shall assume, in applicant's favor, that these three documents suffice to establish that there are three third parties rendering services which are related or similar to the services involved in this case, under, respectively, the trade name and service marks "Vista Analytics, LLC," "Keyport Vista

⁸ Opposer contends in its reply brief that we should disregard these documents because they are not authenticated and they lack foundation. We need not and do not rule on opposer's objections because, even assuming that the documents are properly of record, we find that they do not create a genuine issue of material fact.

Variable Annuity," and "VISTACare."⁹ Based on this inference and in the absence of any countervailing evidence from opposer, we find that there is no genuine issue of material fact that, under the sixth *du Pont* factor, there are three third parties who are using similar marks in connection with similar services. By the same token, however, we also find that applicant's Schedule A evidence establishes only the existence of those three third-party uses. There is no basis in the record from which we might reasonably infer that there are any other such third-party uses of similar marks in connection with similar services.

Thus, we find, under the sixth *du Pont* factor, that the undisputed evidence of record establishes that there are

⁹ In actuality, it does not appear that there is any reasonable basis for inferring that the services rendered by Vista Analytics, LLC are similar to the services at issue in this case, nor for inferring that this third party's services are rendered or marketed to the individual investor/consumers who are the relevant purchasing public in this case. Rather, it appears from applicant's exhibit that Vista Analytics, LLC is "a national provider of managed account programs for financial advisors and broker/dealers," and that its services are marketed "to independent advisors and broker/dealer channels." For purposes of opposer's summary judgment motion, however, we will assume that the services offered by Vista Analytics, LLC are "similar" to the services involved in this opposition, and that this third-party use therefore is relevant under the sixth *du Pont* factor. Similarly, the third of the three third-party uses identified in applicant's Schedule A is the use by Physicians Mutual Insurance Company of the mark "VISTACare" in connection with "long term care insurance." It is not immediately apparent from the record that long term care insurance is "similar" to opposer's mutual fund investment services or to applicant's various financial services, within the meaning of the sixth *du Pont* factor. Again, however, we will assume that such is the case, and that this third-party use is relevant evidence under the sixth *du Pont* factor.

three third-party uses of VISTA marks in the financial services industry. This evidence weighs in applicant's favor in our likelihood of confusion analysis, but only slightly, given the de minimis number of such third-party uses.

Summary and Conclusions

After careful consideration of the evidence of record, we find that there are no genuine issues of material fact as to any of the relevant *du Pont* likelihood of confusion factors which require trial for their resolution.¹⁰ The evidence of record pertaining to the *du Pont* factors, viewed most favorably to applicant and including any reasonable

¹⁰ Opposer has argued that, by virtue of its successful opposition to registration of certain VISTA marks by Chase Manhattan Corporation, it has established its right to exclude others from use of VISTA marks in connection with financial services. Presumably, opposer is contending that this constitutes evidence under the eleventh *du Pont* evidentiary factor, i.e., "the extent to which applicant has a right to exclude others from use of its mark on its goods." Applicant argues in response (without citation to any authority) that because the Chase Manhattan oppositions were terminated as a result of voluntary abandonments of the involved applications, rather than as a result of a substantive decision on the merits in opposer's favor, there is a genuine issue of material fact as to the extent to which the outcome of those prior proceedings establishes opposer's right to exclude others from use of its mark. We are not persuaded by either party's argument, because the eleventh *du Pont* factor is irrelevant in this case. That factor requires us to consider evidence pertaining to the applicant's right to exclude others from use of its mark, not as to the opposer's right to exclude others. There is no such evidence in the record, and the eleventh *du Pont* factor therefore is neutral in this case. It does not weigh in opposer's favor in our determination of whether opposer is entitled to summary judgment, and, contrary to applicant's argument, it cannot possibly give rise to any genuine issue of material fact.

inferences which may be drawn in applicant's favor, establishes beyond dispute that applicant's mark is similar to opposer's mark; that applicant's services (as recited in the application) are similar to and in certain respects legally identical to opposer's services; that applicant's services (as recited in the application) and opposer's services are marketed in the same trade channels and to the same classes of purchasers; that opposer's mark is a strong mark, even if not necessarily a famous mark; and that there are three (and only three) third-party common law users of VISTA-formative marks for services which are "similar" (as generously defined) to the services involved in this case.

Based on these undisputed facts, we find as a matter of law that a likelihood of confusion exists in this case. As discussed above, the only one of the *du Pont* factors which weighs in applicant's favor is the sixth factor, "the number and nature of similar marks in use on similar [services]," and even that factor weighs in applicant's favor only minimally, in view of the de minimis number of third-party uses of VISTA marks in the financial services field. By contrast, the other *du Pont* factors as to which evidence is of record all weigh clearly and heavily in opposer's favor. Given the paucity of evidence in applicant's favor and the great weight of evidence in opposer's favor, there is no reasonable basis, on this

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record, for concluding that there is no likelihood of confusion.

In summary, we find that there are no genuine issues of material fact, and that opposer is entitled to judgment as a matter of law. Therefore, we grant opposer's motion for summary judgment. See Fed. R. Civ. P. 56(c).

Decision: Opposer's motion for summary judgment is granted. The opposition is sustained, and registration to applicant is refused.